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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,856	05/24/2005	Laurent Masaro	14725-8US	4826

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EXAMINER	
FAISON GEE, VERONICA FAYE	

ART UNIT	PAPER NUMBER
1793	

MAIL DATE	DELIVERY MODE
08/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,856	MASARO ET AL.	
	Examiner	Art Unit	
	VERONICA FAISON GEE	1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-13 and 15-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-13,15-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5-6, and 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-294792.

JP 2001-294792 teach a biodegradable composition comprising at least one biodegradable resin selected from the group consisting of polylactic acid, cellulose acetate, polyvinyl alcohol, polycarprolactone, polybutylene succinate and polyethylene succinate and an edible colorant (abstract). The reference further teaches that the composition may be applied by flexographic printing (0001). The edible colorant may be a dye or pigment (0013). The composition may also comprise an additive agent such as solvent, dispersing agent, a surface-active agent, an antifriction agent, an antifungal agent, a preservative, an antioxidant, thickening stabilizer and a brightening agent (0014). The general composition comprises 0.5 to 90 percent by weight of resin, 0.3 to 60 percent of edible colorant, 0 to 95 percent by weight of additive agents and others (0018). The range for the resin as taught by JP 2001-294792 possesses sufficient specificity to anticipate the range of resin as claimed by Applicant. The composition may comprise a resin other than the biodegradable resin (0022). The composition as taught by JP 2001-294792 appears to anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5-9, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stockl et al (US patent 4,883,714).

Stockl et al teach an aqueous printing ink or semi-aqueous or non-aqueous concentrate exemplified as comprising substantially homogeneous system components: 1) about 4 to about 80 weight percent of one or more polyester materials, 2) about 1 to about 60 weight percent of pigment material, 3) from substantially none to about 90 weight percent of water and 4) from about 0.05 to about 30 weight percent of polyvinyl alcohol (abstract, col. 1 line 30-col. 2 line 21). The reference further teaches that the ink composition may be used as a flexographic ink (col.1 line 64-col. 2 line 24). The method disclosed by the reference include the steps of a) dispersing the polymer material in water, b) adding polyvinyl alcohol to the dispersion of a) with agitation to obtain a substantially homogeneous mixture, c) adding pigment of the mixture of b) with agitation to form a pre-dispersion blend; and d) grinding the blend of c) to reduce the pigment particle size (col. 8 line 65-col. 9 line 7).

Stockl et al and the claims differ in that Stockl et al does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Stockl et al overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stockl et al (US Patent 4,883,714) in view JP 2001-294792.

Stockl et al is described above, but fails to teach components set forth in claim 12.

JP 2001-294792 teaches a biodegradable composition. The reference also teaches that additive agent such as solvent, dispersing agent, a surface-active agent, an antifriction agent, an antifungal agent, a preservative, an antioxidant, thickening stabilizer and a brightening agent (0014).

Therefore it would have been obvious to one of ordinary skill in the art to add additives as taught by JP 2001-294792 to the composition of Stockl et al as Stockl et al teaches a composition similar to JP 2001-294792.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stockl et al (US Patent 4,883,714).

Stockl et al and the claims differ in that Stockl et al does not teach the exact same proportions as recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the compositional proportions taught by Stockl et al overlap the instantly claimed proportions and therefore are considered to establish a prima facie case of obviousness. It would have been obvious to one of ordinary skill in the art to select any portion of the disclosed ranges including the instantly claimed ranges from the ranges disclosed in the prior art reference, particularly in view of the fact that;

> "The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages", In re Peterson 65 USPQ2d 1379 (CAFC 2003).

Also, In re Geisler 43 USPQ2d 1365 (Fed. Cir. 1997); In re Woodruff, 16 USPQ2d 1934 (CCPA 1976); In re Malagari, 182 USPQ 549, 553 (CCPA 1974) and MPEP 2144.05.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 5-13,15-17 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERONICA FAISON GEE whose telephone number is

(571)272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerry A Lorengo/
Supervisory Patent Examiner, Art Unit 1793

/V. F. G./
Examiner, Art Unit 1793